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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,869	04/09/2004	Werner Berens	P25088	9283

7055 7590 05/11/2005

GREENBLUM & BERNSTEIN, P.L.C.  
1950 ROLAND CLARKE PLACE  
RESTON, VA 20191

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT PAPER NUMBER

1615

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/820,869	<b>Applicant(s)</b> BERENS ET AL.	
	<b>Examiner</b> JYOTHSNA A. VENKAT Ph. D	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-40 is/are pending in the application.
- 4a) Of the above claim(s) 8,9,12-14,23,30 and 33-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-7,15-22,24-29 and 36-40 is/are rejected.
- 7) ☒ Claim(s) 10,11,31 and 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/6/04</u> | 6) <input type="checkbox"/> Other: ____  |

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### **DETAILED ACTION**

Receipt is acknowledged of election filed on 2/14/05.

#### ***Election/Restrictions***

1. Applicant's election with traverse of group I in the reply filed on 2/14/05 is acknowledged. The traversal is on the ground(s) that the searches for the two different inventions should overlap significantly and the search is not a serious burden. This is not found persuasive because the search for both groups is a search burden as both the groups are drawn to different classes. It is also search burden in the non-patent literature. Art anticipating or rendering obvious purines would not anticipate or render obvious pyrimidines.

The requirement is still deemed proper and is therefore made FINAL.

Due to an inadvertent typographical error, claims 14 and 35 were not included in group II. This error is regretted.

2. Claims 8-9, 12-14, 23, 30 and 33-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2/14/05.

Claims 3-7, 10-11, 15-22, 24-29, 31-32 and 36-40 are pending in the application and the status of the application is as follows:

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 3-7, 16, 20, 22, 24-29, 36 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 5,998,423 ('423).

See col.2, lines 7-12, lines 58-62 for the claimed method, which is melanin production. See xanthines, which read on the claimed purines. See page 6 of the specification for the scope of purines. The structure shown in the patent is tautomer of the structure disclosed at page 6 of the specification. See col.5, lines 48-65 for the concentration of the active ingredient and spray formulations. See claims 1-2. The patent discloses “ method for modulating melanin production” by applying to the hair which reads on the claimed “ hair treatment”.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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7. Claims 3-7, 15-22, 24-29, and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patent '423 and Harry's Cosmeticology pages 431-432 (1982).

The patent does not teach the limitation of claim 15 wherein the composition has antioxidant and claims 17-21 and 37-40 wherein the compositions are in the form of shampoo, hair rinse or shower bath. The patent at col.5, lines 60-65 teach various formulations. Shower baths are in the form of gels and hair conditioners and shampoos are in the form of solutions. The patent teaches various additives that can be used but does not teach antioxidants. Harry's cosmeticology at pages 431-432 teaches the various ingredients that are used in shampoo formulations. The cosmeticology teaches antioxidants at page 432.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '423 using purines and using these compositions for stimulating the melanogenesis and use in various formulations and add the conventional ingredient like antioxidant expecting beneficial effect. One of ordinary skill in the art would be motivated to add antioxidant with the reasonable expectation of success that antioxidants increase the shelf life of the product. It is a prima facie case of obviousness.

***Allowable Subject Matter***

8. Claims 10-11 and 31-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is

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571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K. PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**JYOTHSNA A VENKAT Ph. D**  
**Primary Examiner**  
**Art Unit 1615**

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